

### **REMARKS**

Entry of this Request for Reconsideration is proper under 37 C.F.R. §1.116 since no new claims, claim amendments, or issues are being presented. The claim amendments of the previously-submitted Amendment Under 37 CFR §1.116, which the Examiner refused to enter, are considered as not being necessary, based on the Examiner's indication in the Advisory Action mailed on May 3, 2007, that the non-statutory subject matter rejection was to be withdrawn. Therefore, since the claim amendments of the previously filed Amendment Under 37 CFR §1.116 were entirely due to an attempt to address the non-statutory subject matter rejection, this second Amendment Under 37 CFR §1.116 reverts back to the original claims and is used only for purpose of filing a second Rule 132 affidavit that addresses the concerns of the Examiner for the first affidavit filed on April 16, 2007.

Claims 1-33 are all the claims presently pending in the application.

It is noted that the claim amendments, if any, are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims, or for any statutory requirements of patentability (since Applicants maintain that results inherent from steps described in method claims do not have to be expressly articulated in the claims). Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-33 stand rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter, although the Examiner indicated in the Advisory Action mailed on April 3, 2007, that this rejection would be withdrawn. Claims 1-33 stand rejected under 35 U.S.C. §102(a) as anticipated by the inventors' IEEE presentation for a conference dated December 9, 2002, wherein some aspects of the present invention were published albeit within one year of the filing of the present application.

These rejections are respectfully traversed in the following discussion.

#### **I. THE CLAIMED INVENTION**

The claimed invention, as exemplarily defined in independent claim 1, is directed to a

method of processing an inductive learning model for a dataset of examples. The dataset is divided into a plurality of subsets of data. An estimated learning model for the dataset is then developed by developing a learning model for a first subset of the plurality of subsets.

Conventional methods, as described at line 21 of page 3 through line 6 of page 4, of learning model methods for a database require that the entire database be evaluated before the effects of hypothetical parameters for a test model are known. This process can take many hours (or days) and be costly, so that it can be prohibitive to spend so much effort in the development of an optimal model to perform the intended task.

In contrast, the present invention provides a method to develop an inductive learning model in much shorter time, including an estimate of the accuracy of the model as currently developed and an estimated cost to develop a complete model of the entire database.

## **II. THE 35 USC §101 REJECTION**

Claims 1-33 stand rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter.

In the Advisory Action mailed on May 3, 2007, the Examiner indicated that the 35 U.S.C. §101 rejection will be withdrawn with the recognition that the present invention has the practical application of being used for campaign letter distribution or credit card fraud.

However, Applicants respectfully traverse the Examiner's characterization in the Advisory Action that the present invention is limited to these two applications, since these were clearly described as only exemplary. Other possible applications were clearly identified in the first sentence on page 2 of the specification: "*Inductive learning has a wide range of applications that include, for example, fraud detection, intrusion detection, charity donation, security and exchange, loan approval, animation, and car design, among many others.*" Moreover, in various places in the specification, such as lines 10-16 of page 4 of the specification, Applicants indicated the usefulness of the present invention in any scenario using any basic inductive learning model.

Therefore, Applicants submit that the present invention is not at all limited to the two specific examples of campaign letter distribution or credit card fraud detection, as implied by the

Examiner in the Advisory Action.

Given the Examiner's awareness of the practical applications of the present invention, Applicants respectfully request that the Examiner formally withdraw the rejection based on 35 USC §101 in the next Office Action.

### III. THE PRIOR ART REJECTION

The Examiner alleges that Applicants' own publication dated December, 2002, anticipates the present invention.

On page 18 of the latest Office Action, the Examiner writes:

*"The Examiner acknowledges the art is within the one year grace period of the filing date. The problem [that] arises is that the inventive entity is not the same. Authors Shaw-hwa Lo and Salvatore Stolfo are not listed as inventors. Additionally both Shaw-hwa Lo and Salvatore Stolfo are affiliated with Columbia University and not International Business Machine[s]. Therefore the art 'Progressive Modeling' is valid to use."*

In response, Applicants submit that the authorship listing of the reference publication is not, and never has been, intended as an indication of the status of being a co-inventor for the present invention. The names of these two students were added to a publication merely as a benefit and courtesy so that these students could add the publication to their academic credentials as a specific topic they encountered during their trainee experience at IBM.

Moreover, Applicants submit that merely adding someone's name to a publication is not a concession by the Assignee that the person is necessarily a co-inventor. The Assignee's normal practice for adding names as a courtesy to such publications, when there is no contribution to actual conception or reduction to practice, is that these names are listed at the end of the authorship listing. If either Lo or Stolfo had provided any contribution that is properly attributable as inventive in nature to the object of the publication, their names would have been properly identified, depending upon relative contribution, either at the front of the listing or in strict alphabetical listing along with the listed IBM co-inventors.

In the instant case, the listing on this IEEE publication shows the two non-IBM-employees at the end of the listing of authors and outside the alphabetical listing of the IBM co-inventors.

In the Advisory Action mailed on May 3, 2007, the Examiner alleges that the previously-

filed Rule 132 Affidavit was deficient for failing to include signatures for all co-inventors and for failing to use the terminology “not by another.”

In response, Applicants submit herewith a second Rule 132 affidavit including all three co-inventors and the desired wording. It is noted that co-inventor Fan was unavailable for signature when this Request for Reconsideration was prepared and filed, but his signature will be submitted within a week, thereby completing the formalities for the second affidavit.

Applicants also understand that the Rule 105 requirement for information is rendered moot by the submission of the second affidavit, since there is no longer any need to identify specific claims for each co-inventor or any need to provide additional documentation supporting the co-inventors’ declaration in the affidavit that they alone are the true inventors.

However, in an attempt to address the Examiner’s request for any information on any prior art search results, Applicants are checking again into whether Assignee did a prior art search for this Application. It is noted, however, that this Assignee normally and routinely submits any such prior art search results with all new applications for which such searches are done, thereby suggesting that no prior art search was done for this particular application.

Given the submission of the second Rule 132 affidavit and the Examiner’s statement in the Advisory Action that the non-statutory subject matter rejection would be withdrawn, Applicants believe that the originally-filed claims are in condition for immediate allowance and the Examiner is, therefore, respectfully requested to withdraw this rejection.

#### **IV. FORMAL MATTERS AND CONCLUSION**

In view of the foregoing, Applicant submits that claims 1-33, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Serial No. 10/725,378  
Docket No. YOR920030321US1 (YOR.483)

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



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**CERTIFICATION OF TRANSMISSION**

I certify that I transmitted electronically, via EFS, this Amendment Under 37 CFR §1.116 to Examiner P. Coughlan on May 15, 2007.



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